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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jonathan Sharp

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09/18/2006

BANNER & WITCOFF

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SUITE 1100

WASHINGTON, DC 20001

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,547

Applicant(s)

SHARP ET AL.

Examiner

Victor Lesniewski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 7/10/2006 has been placed of record in the file.
2. Claims 15, 18, 19, and 22 have been amended.
3. Claims 28-32 have been added.
4. Claims 15-32 are now pending.
5. The applicant's arguments with respect to claims 15-27 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Response to Amendment

6. Claims 15, 18, 19, and 22 have been amended to correct typographical errors in the claims. The amendment does not prove a change in scope to the limitations of these claims. Claims 28-32, which have been added, recite limitations not previously presented in the claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Peng (U.S. Patent Number 6,816,944).

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9. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a server are rejected under the same rationale applied to the described claim.

10. Peng has disclosed:

- <Claims 15, 18, and 22>

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising: providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48); providing said adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26); downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26); monitoring downloading of said adaptation data by said portable radio communication device from said memory of said server to provide output data (column 7, lines 38-44); applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and computing remuneration data related to the electronic content and the adaptation data based on the generated data (column 7, lines 44-46).

- <Claims 16 and 19>

A method according to claim 15, wherein: a content provider provides said electronic content for storage on the memory of said portable radio communication device (column 8, lines 8-18 and 31-48); the content provider provides said adaptation data for storing on the memory of said server (column 15, lines 3-15); a content enabler allows access to said adaptation data for downloading from said memory of said server to said portable radio communication device (column 15, lines 13-26); and the content enabler provides for monitoring downloading of said adaptation data by said portable radio communication device from the server, generating data based on monitoring downloading of said content, and computing the remuneration data based on the generated data, the content enabler determining payment data for said content provider based on said remuneration data (column 7, lines 38-46).

- <Claims 17 and 20>

A method according to claim 15, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 21>

A portable radio communication device operable in a radio communication network including a server, the portable radio communication device being capable of downloading adaptation data from the server, the portable radio communication device having a transceiver, a memory and a controller (column 5, lines 1-16 and column 7, lines 12-18), wherein: the memory stores electronic content (column 8, lines 8-18 and 31-48);

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the controller is operable to control the transceiver to transmit a request for adaptation data from the server, the request comprising an identifier of the electronic content stored on the device and security data, the identifier and the security data enabling the server to download the adaptation data to the portable radio communication device, the transceiver receives said adaptation data from the server, and the controller modifies the electronic content stored on the memory by applying to the electronic content the received adaptation data to provide adapted data which is stored on said memory (column 7, lines 48-53 and column 15, lines 3-26); the transceiver in response to said storing of the adaptation data transmits an acceptance signal (column 7, lines 38-44); and said acceptance signal is used by the server for computing remuneration data related to the adaptation data (column 7, lines 44-46).

Since all the limitations of the invention as set forth in claims 15-22 were disclosed by Peng, claims 15-22 are rejected.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng.

13. Concerning claims 23, 26, 30, and 32, Peng did not explicitly state determining if the generated data includes an indication that the adaptation data has been successfully applied to the

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electronic content. However, Peng does use a transaction manager in order to track the progress and status of each transaction. Peng also bills the user for certain transactions. It is clear that when a service provider bills a user for some network activity or transaction, it would be in response to the actual activity or transaction (i.e. a service has been rendered). Thus, it is also clear that the system would make some determination that the transaction was completed successfully or the service rendered before billing the user. In view of the foregoing, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to determine if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content. Normal network service providers would not bill a user for a service without first rendering the service.

14. Concerning claims 28, 29, and 31, Peng did not explicitly state providing payment based on the remuneration data. However, Peng does track user transactions and bill for various user activities or transactions. Further, providing payment for services over a network was well known in the art and it is clear when a service provider bills a user for some network activity or transaction, payment is expected to be provided. In view of the foregoing, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to provide payment based on the remuneration data.

15. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a server are rejected under the same rationale applied to the described claim.

16. Thereby, Peng discloses:

- <Claims 23 and 26>

A method for downloading adaptation data from a server to a portable radio communication device, comprising: allowing at least selective access to the adaptation data on a memory of the server for download to the portable radio communication device (column 5, lines 17-37 and column 15, lines 3-26); downloading the adaptation data from the memory of the server to the portable radio communication device (column 15, lines 3-26); applying the adaptation data to electronic content stored on the portable radio communication device so as to modify the electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the applying of the adaptation data to the electronic content (column 7, lines 38-46); and if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content (obviousness as discussed above in paragraph 13), computing remuneration data related to the electronic content and the adaptation data based on the generated data (column 7, lines 44-46).

- <Claims 24 and 27>

A method according to claim 23, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 25>

A method according to claim 23, further comprising, before downloading the adaptation data, determining whether the portable radio communication device is entitled to access to the adaptation data, and wherein the adaptation is downloaded to the portable radio

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communication device only if the portable radio communication device is entitled to access the adaptation data (column 7, lines 46-53).

- <Claim 28>

A method according to claim 16, further comprising providing payment, by the content enabler, to the content provider based on said remuneration data (obviousness as discussed above in paragraph 14), wherein said remuneration data corresponds to one or more downloads of said adaptation data from said server by one or more end-users (column 7, lines 38-53).

- <Claim 29>

A system according to claim 19, wherein said remuneration data corresponds to one or more downloads of said adaptation data from said memory of said server by one or more end-users and wherein the content enabler comprises the determination means which records the one or more downloads of said adaptation data from said server by the one or more end-users (column 7, lines 38-53) and provides payment to the content provider based on said remuneration data (obviousness as discussed above in paragraph 14).

- <Claim 30>

A portable radio communication device according to claim 21, wherein the acceptance signal contains an indication that the adaptation data has been successfully applied to the electronic content (obviousness as discussed above in paragraph 13).

- <Claim 31>

A portable radio communication device according to claim 21, wherein the server computes the remuneration data based on one or more downloads of the adaptation data

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to the portable radio communication device (column 7, lines 38-53) and the server provides payment to a provider of the electronic content based on the remuneration data (obviousness as discussed above in paragraph 14).

- <Claim 32>

A server according to claim 22, wherein the computing means computes remuneration data only if the generated data comprises an indication that the adaptation data has been successfully applied to the electronic content (obviousness as discussed above in paragraph 13).

Since Peng discloses all of the above limitations, claims 23-32 are rejected.

Response to Arguments

17. In the remarks, the applicant has argued:

- <Argument 1>

Peng does not disclose the features of claim 15 because he does not disclose “computing remuneration data” as recited in claim 15.

- <Argument 2>

The provisional application (60/179,761) upon which Peng relies does not contain sufficient disclosure to support the rejection based on the functionality of Peng’s transaction manager (ie. tracking transaction progress, checking statuses, billing, etc.).

18. In response to argument 1, Peng does disclose computing remuneration data as recited in claim 15. The previous line citation, column 7, lines 44-46, clearly states that the system computes a detailed record of each user’s billable activities. This detailed record satisfies the

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limitation of remuneration data as stated in the claim. The claim does not contain any further definition of remuneration data besides that it is “related to the electronic content and the adaptation data based on the generated data.” Peng’s detailed record meets this limitation.

Regarding the applicant’s remarks concerning the statement that “this is not a limitation of the claims” in the previous action, the statement was clearly referring to the applicant’s assertion that the claims state that the system “performs computations to determine a charge to be levied.” Again, this is not a limitation of the claims. See paragraph 15 of the previous action dated 4/12/2006.

19. In response to argument 2, it is maintained that the provisional application upon which Peng relies does contain sufficient disclosure to support the rejections stated herein. Concerning the functionality of Peng’s transaction manager, see page 77, section 3.3.4 of the provisional application.

20. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

21. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

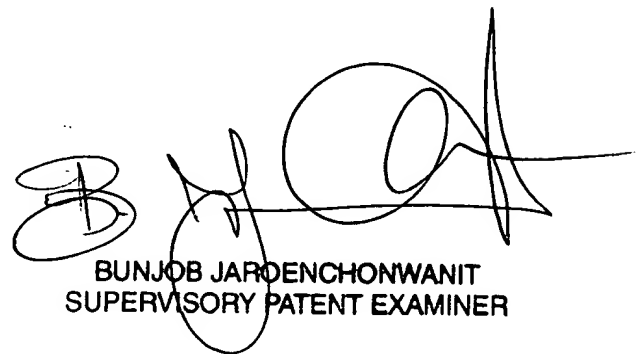
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



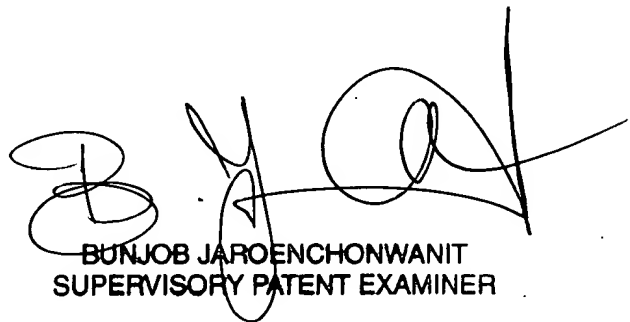
BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

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Victor Lesniewski
Patent Examiner
Group Art Unit 2152



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER